REMARKS

Claims 2-4, 11-19 and 27-36 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite for certain informalities. Applicant has amended the claim set to correct the informalities by providing the rejected claims with proper antecedent basis. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 17 stands objected to for use of the phrase "may be" as being indefinite. Applicant has amended claim 17 by replacing the phrase with "is." Reconsideration and withdrawal of the objection is respectfully requested.

Claims 1-2, 5-12, 21-25, 26-28, 31-34 and 35-39 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 20040111669 of Rossmann, *et al.* Rossmann discloses a system and method of processing a web page. (Rossmann, Abstract). Rossmann discloses the method as including receiving a web page having a number of data elements, classifying the data elements, determining a number of related operations for each of the data elements and outputting the related operations. (Rossmann, Abstract). As Rossmann discloses, the data is extracted from the web page, the user selects one or more related operations, and the extracted data are then output to the one or more related operations, which then processes the extracted data. (Rossmann, ¶ 44). Selecting the related operation causes the extracted data to be sent to the application implementing the related operation. (Rossmann, ¶ 44). For example, using a hotel booking application, the process books a hotel by contacting the hotel booking website, makes reservations, sends confirmations to user, etc. (Rossmann, ¶ 74). It is significant to note that the processor used in the method controls and sends instructions to the remote terminals, as in the case of booking the hotel reservation. As discussed during the telephone interview with the Examiner, claims 13-17 of Rossmann disclose that the processor is coupled to the user terminal.

Applicant claims, *inter alia*, recording a destination address for a communications terminal having an electronic telephone directory in a browser, selecting one or more telephone numbers to

PAGE 12/15 * RCVD AT 8/19/2005 2:28:42 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID:713 939 9508 * DURATION (mm-ss):04-30

capture from a Web page, and sending a message containing the captured telephone numbers to the communications terminal. (Claims 1, 21, 27 and 37).

MPEP § 2131 provides:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented because each and every element as set forth in Applicant's claim is not found in the cited prior art reference. Applicant claims recording a destination address of a communications terminal having an electronic telephone directory in a browser. The Examiner cites Rossmann at ¶ 85 as disclosing that an address of a telephone directory may be recorded as a bookmark. (Office Action, p. 4, ¶ 8). Applicant cannot find such a reference in ¶ 85 of Rossmann and cannot find any mention of a bookmark in Rossmann. Applicant claims that the address of the communications terminal is recorded in a web browser running on a computer, which Applicant differentiates in the claims from the server hosting the Web page. (claims 1, 21, 27, 37). Rossmann discloses that the addresses with which it communicates are found within the Web page being controlled, not within the browser.

The Examiner states that because Applicant claims that either the computer running the browser or the server hosting the Web page can be the captor, that the Applicant is assuming that the server must also have used a browser to record the destination address of the communication terminal. (Office Action, p.3). Such is not what Applicant claims. Applicant claims that the browser running on the computer has been recorded with the address of the communications terminal. The fact that either the server hosting the web page or the computer running the browser can capture a telephone record and send that telephone record to the address of the communications terminal does not change Applicant's claim that states that the address of the communication terminal *is recorded in the browser that is being run on the computer*, not on the server that is

PAGE 13/15 * RCVD AT 8/19/2005 2:28:42 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID:713 939 9508 * DURATION (mm-ss):04-30

hosting the Web page. Rossmann fails to disclose that the terminal address is recorded within the browser.

As stated above, a *prima facie* case of anticipation requires that each and every element as set forth in Applicant's claims are found, either expressly or inherently described in a single prior art reference. Since Rossmann does not set forth each and every element as set forth in Applicant's claims, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 21, 27 and 37 as well as all claims depending therefrom.

Claims 3-4 and 29-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 20040111669 of Rossmann, *et al.*, as applied to claim 1-2, 5-12, 21-24, 26-28, 31-33, 35 and 37-39 above and further in view of Official Notice. Claims 13-15, 17-20, 25, 34 and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 20040111669 of Rossmann, *et al.* For the reasons cited in the remarks above concerning independent claims 1, 21, 27 and 37, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 3-4 and 29-30 that depend, either directly or indirectly, from independent claims 1, 21, 27 or 37.

Furthermore, MPEP § 2144.03 states:

> If the applicant does not seasonably traverse a claim by the Examiner of a well known statement during examination, then the object of the well known statement is taken to be admitted prior art. A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, an applicant is charged with rebutting the well known statement in the next reply after the office action in which the well known statement was made.

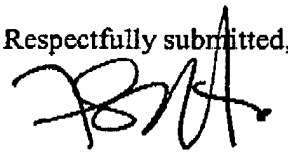
Applicant therefore respectfully rebuts the Official Notice claimed by the Examiner in this rejection. Applicant does not claim a simple updating of a database but rather claims updating a telephone directory *automatically* and sending a notice or warning *only* if a number already exits. This is not the same as what the Examiner states as official notice.

Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests that a Notice of Allowance be issued. If the Examiner determines that a

PAGE 14/15 * RCVD AT 8/19/2005 2:28:42 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID:713 939 9508 * DURATION (mm-ss):04-30

telephone conference would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM-0019 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



Frank J. Campigotto
Attorney for Applicant
Registration No. 48,130
STREETS & STEELE
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
(713) 939-9444

PAGE 15/15 * RCVD AT 8/19/2005 2:28:42 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID:713 939 9508 * DURATION (mm-ss):04-30